

The opinion in support of the decision being entered today was not written for publication in a law journal and is not binding precedent of the Board.

Paper No. 23

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KAZUO MINEMURA

Appeal No. 1999-1374
Application 08/527,679

Before STONER, Chief Administrative Patent Judge, HARKCOM, Vice Chief Administrative Patent Judge, and WILLIAM F. SMITH, Administrative Patent Judge.

WILLIAM F. SMITH, Administrative Patent Judge.

REMAND TO THE EXAMINER

Our consideration of the record leads us to conclude that this case is not in condition for a decision on appeal. Accordingly, we remand the application to the examiner to consider the following issues and to take appropriate action.

The examiner entered an Examiner's Answer on December 4, 1998 (Paper No. 17). Therein, claims 1, 3, 6, and 7 were rejected under 35 U.S.C. § 103(a) inter alia on the basis of German Patent No. DE43 37 374 with the examiner referring to page 2, right column, line 49 and Figures 1, 2, 4, and 5 of the German document. A review of the application file contents as forwarded to the Board indicates that the only copy of

the German Patent was in the German language. It is unclear from this record on what basis the examiner considered the document in its entirety.

Appellant filed a "Letter" on December 7, 1998 (Paper No. 18) which included an English translation of the German Patent. It appears that this is the first time a translation of the German document was made of record. In the letter, appellant asked the examiner to note specific passages in the translation as supporting appellant's position that the claims on appeal are patentable.

While appellant's copy of the translation was filed after the mailing date of the Examiner's Answer, it was of record when the Reply Brief was filed (Paper No. 19, February 4, 1999). Appellant's remarks in the Reply Brief are directed to the "complete translation of German Patent DE43 37 374 A1." Clearly at this point in time, appellant's arguments for patentability were based upon the translation of the document.

The examiner issued a communication on February 16, 1999, indicating that the Reply Brief had been entered and considered and that the case would be forwarded to the Board for a decision. The examiner did not acknowledge appellant's submission of the complete text translation of the German document or the shift in position on appeal to arguing for patentability of the claims based upon the translation of the document.

An obviousness inquiry under 35 U.S.C. § 103 is fact-intensive. It stands to reason that a full text translation of a patent document would reveal more facts relevant

to a patentability determination than an abstract of the foreign language document. For reasons unclear from this record, the examiner and appellant were satisfied until the entry of the Answer to determine the patentability of the claims on appeal on the basis of the English language abstract. While appellant submitted a translation of the document after the Answer was entered, the examiner did not step back and reevaluate his position in regard to the patentability of the claims on appeal on the basis of the new fact record presented by the translation.

As stated in Gechter v. Davidson, 116 F.3d 1454, 1457, 43 USPQ2d 1030, 1033 (Fed. Cir. 1997), "For an appellate court to fulfill its role of judicial review, it must have a clear understanding of the grounds for the decision being reviewed," which requires that " [n]ecessary findings must be expressed with sufficient particularity to enable [the] court, without resort to speculation, to understand the reasoning of the Board, and to determine whether it applied the law correctly and whether the evidence supported the underlying and ultimate fact findings."

Like the Court of Appeals in Gechter, this Board requires a clear understanding of the grounds for the decision being reviewed. In this case, the examiner has relied upon a German language document, and has directed attention to passages in the document to support the rejection. We find it impossible to understand the examiner's reasoning and whether the evidence upon which he relies supports the underlying fact

findings for the rejection under §103.

The Board cannot examine, in the first instance, all applications which come before us in an ex parte appeal under 35 U.S.C. § 134. As is the practice of the Board we have also obtained a translation of the German language document. Upon return of the application, the examiner should reassess the patentability of the rejected claims on the basis of the full text translations of the German document. In so doing, the examiner should consult both the appellant's translation and the translation provided for the Board by the United States Patent and Trademark Office. If there are any discrepancies between the two documents, the examiner and appellant should discuss and resolve the matter.

If upon reconsideration of the merits of the rejection under 35 U. S .C. § 103(a), the examiner determines that the full text translation of the German document provides a basis for rejecting the claims under this section of the statute, the examiner should issue an appropriate Office action setting forth the facts and reasons in support of that determination. In this regard, we state that we are not authorizing a Supplemental Examiner's Answer under 37 CFR § 1.193(b)(1). Any further communication from the examiner which includes a rejection of the claims should provide appellant with a full and fair opportunity to respond.

We also note that appellant filed an Information Disclosure Statement on

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August 4, 2000. Upon return of the application, the examiner should consider the Information Disclosure Statement and take whatever action is deemed appropriate.

This application, by virtue of its "special" status, requires an immediate action. Manual of Patent Examining Procedure § 708.01 (7th ed., rev. 1, February 2000). It is important that the Board be informed promptly of any action affecting the appeal in this case.

REMANDED

Bruce H. Stoner, Jr., Chief
Administrative Patent Judge

Gary V. Harkcom, Vice Chief
Administrative Patent Judge

William F. Smith
Administrative Patent Judge

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